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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,967

07/12/2006

Jonny Boyd Reckless

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PATENT DEPARTMENT  
MACROVISION CORPORATION  
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EXAMINER

SQUIRES, BRETT S

ART UNIT

PAPER NUMBER

2131

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,967	<b>Applicant(s)</b> RECKLESS ET AL.	
	<b>Examiner</b> BRETT SQUIRES	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 24-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 24-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/12/06, 01/30/07, 03/09/07</u> .                            | 6) <input type="checkbox"/> Other: _____                          |

***Requirement for Information***

1. The following is a quotation of the appropriate paragraphs of 37 C.F.R. § 1.105 that form the basis for the requirements for information made in this Office action.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(iii) *Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(viii) *Technical information known to applicant*. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

The examiner respectfully requests that all information related to the assignee's Ripguard technology for copy protecting DVDs or other similar technologies for copy protecting DVDs known to the inventors or assignee be submitted to the Office, so that the present application can be properly determined its patentability. The examiner further respectfully requests that all information related defeating the assignee's Ripguard technology for copy protecting DVDs or other similar technologies for copy protecting DVDs known to the inventors or assignee be submitted to the Office, so that the present application can be properly determined its patentable subject matter. Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply. A reply, or a failure to reply, to a requirement for information under this section will be governed by 37 CFR § 1.135 and 1.136.

### ***Priority***

2. The applicant's claim for the benefit of foreign priority based on an application filed in Great Britain on February 4, 2005 having the serial number GB 0502367.6 is denied. The examiner respectfully points out that the foreign priority benefits under 35 U.S.C. 119(a)-(d), are for an application for patent filed in the United States being entitled to the benefit of the filing date of **a prior application** filed in a foreign country. An international application for the purpose of 35 U.S.C. 365 (a)-(b) and 35 U.S.C. 119 (a)-(d) is considered to be a national application regularly filed in that country on the international filing data irrespective of whether the application was physically filed in that country. The present application is the United States nation stage of the PCT GB2005/000370 filed on February 4, 2005. Accordingly, the application filed in Great Britain on February 4, 2005 having the serial number GB 0502367.6 is not a prior application filed in a foreign country.

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Great Britain on February 19, 2004. It is noted, however, that applicant has not filed a certified copy of the GB 0403719.8 application as required by 35 U.S.C. 119(b).

### ***Drawings***

4. The drawings are objected to because two different views of the invention have the same figure number. Figure 8 contains a top view showing cells with the content

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which are to be played provided along a single sequential navigable path and figure 8 contains a bottom view showing an interleaving technique used to provide copy protection. The different view shown in figure 8 must be numbered in consecutive Arabic numerals. See 37 § CFR 1.84(u). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

5. Claims 4 and 7 are objected to because of the following informalities:  
independent claim 1 recites “a corresponding data area,” on page 2 line 22 of the

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preliminary amendment filed July 12, 2006, claim 4, which depends from independent claim 1, recites "a corresponding data area," on page 3 line 7 of the preliminary amendment filed July 12, 2006 and claim 7, which depends from independent claim 1, recites "a corresponding data area," on page 3 line 30 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same corresponding data area. Appropriate correction is required.

6. Claim 10 is objected to because of the following informalities: independent claim 1 recites "a copy protected optical disc," on page 2 line 9 of the preliminary amendment filed July 12, 2006, independent claim 1 then references the copy protected optical disc by reciting "the optical disc," on page 2 line 9 and "the disc" on page 2 lines 14, 16, and 20, claim 10, which depends from independent claim 1, recites "a disc" on page 4 line 2 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same optical disc. Appropriate correction is required.

7. Claims 11 and 13-15 are objected to because of the following informalities: independent claim 1 recites "at least one region which contains subversive data," on page 2 lines 11-12 of the preliminary amendment filed July 12, 2006, claim 11, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 6 of the preliminary amendment filed July 12, 2006, claim 13, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 17 of the preliminary amendment filed July 12, 2006, claim 14, which depends from independent claim 1, recites "at least one region of subversive data," on

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page 4 line 22 of the preliminary amendment filed July 12, 2006, claim 15, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 27 of the preliminary amendment filed July 12, 2006, it is unclear whether the recited claim limitations are intended to refer to the same corresponding at least one region of subversive data. Appropriate correction is required.

8. Claims 25-27 are objected to because of the following informalities: independent claim 24 recites "a corresponding data area," on page 5 line 15 of the preliminary amendment filed July 12, 2006, claim 25, which depends from independent claim 24, recites "a corresponding data area," on page 5 line 28 of the preliminary amendment filed July 12, 2006, claim 26, which depends from independent claim 24, recites "a corresponding data area," on page 6 line 3 of the preliminary amendment filed July 12, 2006, and claim 27, which depends from independent claim 24, recites "a corresponding data area," on page 6 line 9 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same corresponding data area. Appropriate correction is required.

9. Claim 30 is objected to because of the following informalities: independent claim 24 recites "a copy protected optical disc," on page 5 line 1 of the preliminary amendment filed July 12, 2006, independent claim 24 then references the copy protected optical disc by reciting "the optical disc," on page 5 lines 1-2, claim 30, which depends from independent claim 24, recites "an optical disc" on page 6 line 21 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim

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limitations are intended to refer to the same optical disc. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 1 recites the limitation "the or each region of subversive data," on page 2 line 17 of the preliminary amendment filed July 12, 2006. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

13. Claims 1 and 3 recite the limitation "content," with each claim providing a different meaning for the term, thus causing the meaning of "content," to be ambiguous. The term "content," in claim 1 is used by the claim to mean "data accessed during normal playback of the disc", while the term "content," in claim 3 is used by the claim to mean "subversive data." The term is indefinite because the specification does not clearly define the term. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.



Claims 24-28 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 24-28 and 30 recite “apparatus for copying a copy protected optical disc,” comprising an access module, an access device, a storage module, and an incorporation module. The elements used to construct the apparatus for copying allow for the apparatus to be constructed entirely with software and the specification provides an embodiment of the apparatus for copying, disclosed on page 16 lines 6-7, that is comprised of only the appropriate software. Therefore, the claimed apparatus for copying is drawn to functional descriptive material and does not fall into at least one of the four statutory classes defined by 35 U.S.C. 101. If a claim covers material not found in any of those four categories, then the claim falls outside the plainly expressed scope of 35 U.S.C. 101, even if the subject matter is otherwise new and useful. *See In re Nuijten 84 USPQ2d 1495 (Fed. Cir. 2007)*

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 18 of copending Application No. 11/715,144 in view of G@M3FR3@K, "What is Raw," posted May 1, 2001, pages 1-3.

Claim 1 of the present application corresponds to claim 18 of copending application no.11/715,144.

Claim 1 of the present application recites a method of copying a copy protected optical disc comprising "accessing the content on the copy protected optical disc by navigating to the content utilising the navigation paths provided for normal playback of the disc," "storing the accessed content in a corresponding data area," and "including arbitrary data in any regions of the corresponding data area which correspond to regions containing subversive data."

Claim 18 of the copending application recites a method of copying content from a recording medium carrying content data and navigational command data that determines the order in which a player of the recording medium will access the content data comprising "accessing the recording medium to read content data and navigation data from a recording medium," and "storing data for enabling recording of the content data for the navigational path."

Claim 18 of the copending application does not recite the step of "including arbitrary data in any regions of the corresponding data area with correspond to regions containing subversive data."

G@M3FR3@K discloses a method for copying a copy protected optical disc that replaces subversive data with zeros.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the step of replacing subversive data with zeros in the method recited by the copending application no.11/715,144 in order have a defect free copy of the content on the recording medium.

Claim 24 of the present application corresponds to claim 1 of copending application no. 11/715,144.

Claim 24 of the present application recites an apparatus for copying a copy protected optical disc comprising "an access module for accessing the content on the disc by utilising the navigation provided for normal playback of the disc, said access module comprising a mapping module for mapping the navigation paths to identify regions of the data area which are not accessed by said navigation paths, and an access device for accessing regions of the data area which have not been identified as said regions, in a linear manner," "a storage module for storing the accessed content in a corresponding data area," and "an incorporation module for incorporating arbitrary data into any regions of the corresponding data area which correspond to regions containing subversive data."

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Claim 1 of the copending application recites a copying apparatus for copying content from a recording medium comprising “a reader operable to access locations of the recording medium to read content data and navigation data from a recording medium,” “a navigator operable to execute a navigation command in accordance with navigation data read by the reader,” “a controller operable to control the location of the recording medium accessed by the reader in accordance with the execution of a navigation command by the navigator to cause the reader to follow a navigation path through the content data defined by the navigation data and to cause the presentation data storer to store data for enabling recording of the content data for the navigational path,” and “a presentation data storer operable to store content data for recordal onto a recording medium.” The examiner respectfully points out that there are only two options for content on an optical disc. The content is either accessible through navigation paths or the content is not accessible through navigations paths. Accordingly, mapping the content on the optical disc using either option will provide a mapping of all of the content on the disc because the content that does not fall within one classification will by default fall within the other classification. Consequently, mapping the content on the optical disc that is accessible through navigation paths will also provide a mapping for the content that is not accessible through navigation paths.

Claim 1 of the copending application does not recite the element “an incorporation module for incorporating arbitrary data into any regions of the corresponding data area which correspond to regions containing subversive data.”

G@M3FR3@K discloses a method for copying a copy protected optical disc that replaces subversive data with zeros.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an element that performs replacing subversive data with zeros in the method recited by the copending application no.11/715,144 in order have a defect free copy of the content on the recording medium.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-16, 24-28, and 30 are rejected under 35 U.S.C. 102(f) because the applicants did not invent the claimed subject matter, instead the applicants derived the claimed subject matter from the copending Application No. 10/939,186.

The copending application claims a method and apparatus for copy protecting an optical disc carrying content and control data in a data area and the present application claims a method and apparatus for defeating the copending application's copy protection of an optical disc. The defeat of the copy protection for the optical disc is based the inventive entity having specific knowledge of the copy protection technique used for protecting the optical disc. Therefore, the defeat of the copy protection for the optical disc is derivation of the copy protection technique and not an original invention.

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The inventive entity of copending application, (Carmen Laura Basile, Jonny Boyd Reckless, Lee Avery, Glenn Allen Siebert, Kordian Jacek Kurowski), and the inventive entity of the present application, (Jonny Boyd Reckless and Richard AA Heylen), have a common inventor, Jonny Boyd Reckless. The common inventor provides a preponderance of the evidence that the method and apparatus for copy protecting an optical disc carrying content and control data in a data area conceived by the inventive entity of the copending application was communicated to the inventive entity of the present application. The copending application claims domestic priority to the provisional application no. 60/545,979 having a filing date of February 19, 2004, and the present application has an international filing data of February 4, 2005 and claims foreign priority to an application no. GB 0403719.8 filed in Great Britain on February 19, 2004. However, the provisional application cover sheet is marked as being prepared on February 18, 2004. Accordingly, the there is prior conception and communication on the part of the inventive entity of the copending application and the inventive entity of the present application simply derived the claimed subject matter.

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***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRETT SQUIRES whose telephone number is (571) 272-8021. The examiner can normally be reached on 9:00am - 5:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BS/

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